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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,087	06/12/2000	Tariq Khalidi	10015-pa	4895
37095 7590 10/24/2007 BERNHARD KRETEN WEINTRAUB GENSHLEA CHEDIAK SPROULE 400 CAPITOL MALL, 11TH FLOOR SACRAMENTO, CA 95814			EXAMINER PATEL, JAGDISH	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 10/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/592,087	Applicant(s) KHALIDI, TARIQ	
	Examiner JAGDISH PATEL	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendment filed 8/3/07.

Response to Amendment

2. No claims have been amended. Claims 5-7 remain pending.

Response to Arguments

3. Applicant's arguments filed 8/3/07 have been fully considered and deemed persuasive.

Accordingly rejection under 35 USC 103 has been withdrawn.

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e.,) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As an example, the applicant asserts, through the Declaration of the Inventor that the invention as claimed automates competitive bidding by extracting the best value for the acquisition without paying for non-value added items. However, claim 5 does not recite that the process for competitive bidding is automated. None of the steps are performed automatically. On the contrary, all steps are recited as being performed by human

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action. The examiner notes that, based on the recent ruling by the Federal Circuit Court the method claims in the present form are deemed non-statutory (see detailed explanation under 35 USC 101 Rejection).

5. It is suggested that the claim be amended to clearly recite that the critical features of the competitive bidding process is automated via a computer and that the applicant clearly state where support for this automatic process is found in the originally filed disclosure. The claim as recited only recited is carried out manually. For example, the process steps of sequestering, searching, prequalifying, and preparing a bid are interpreted as manually performed process steps.

6. The examiner has found that features of the disclosed invention as presented in paragraphs 3 and 4 of the Declaration are not disclosed by the cited prior art. However, the claim fails to such features. For example, the claim does not recite that the critical features are automated and that the packages communicate directly with other tiers.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 5-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention recites a method which does not qualify as a “useful process” because it is not either “(1) tied to a particular apparatus or (2) operated to change materials to a different state or thing” (quoting “*In Re Stephen W. Comiskey*”, Decided 9/20/2007 in ruling by the US Court of Appeals for the Federal Circuit). As explained before, the claimed method only recites manually performed process and therefore not tied to an apparatus

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such as a computer. The second test is not relevant in the current situation because the claim is not directed to art which involve manufacturing or chemical process which involve transformation of materials. Accordingly, the claimed invention is an abstract and not a statutory process. Alternatively, it is stated that such manual process fail to produce useful, concrete and tangible result due to human involvement in the process as recited.

The applicant should recite the claim such that critical process steps of the method are performed automatically using a computer. The applicant should indicate where support for the amendment is found in the disclosure.

{Examiners Notes:

This action is non-final and any amendment to the claims to resolve the deficiencies identified in the office action will be considered for allowability.

Text of *In re Comiskey* decision is available on with search term "In re Comiskey" on search engine such as Google.

Conclusion

This action is made non-final and the applicant's response will be accordingly treated.

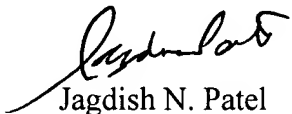
Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on **800AM-630PM-Mon-Tue and Thu.**

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3693)

10/12/07